APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,592	03/27/2001	Steven Larky	CYPR-C00158	3488

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WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER
OSMAN, RAMY M

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/812,592	TAKAHASHI ET AL.
	Examiner	Art Unit
	Ramy M Osman	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) *7 and 12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This communication is responsive to the amendment filed on September 13, 2004.

Applicant amended claims 1,2,5,6, 9-11 and 13-20. Claims 7 and 12 were cancelled. Claims 1-20

are pending.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

3.   Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

In step b), there is no mention of what is contained in the first database, and what type of

match is being searched for. It is not clear what is being matched.

In step d), there is no mention of what is contained in the second database, and what type

of match is being searched for. It is not clear what is being matched.

In step f), there is no mention of what the databases are being updated with. Applicant

must clearly point out what the databases are being updated with.

In step f), the limitation "provided that attachment is attached to said message" is unclear.

Applicant must clearly point out under what circumstances the databases are being updated.

Applicant must also clearly point out when the databases are not being updated.

4.   Claims 14 and 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

The claim language inherits the deficiencies of claim 1 step f) outlined above.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Chrabaszez**

(US Patent No 6,073,133) in view of Meister et al. (US Patent No 6,671,718).

7.   In reference to claim 1, Chrabaszez teaches a method of sending an electronic message

comprising the steps of:

a) examining syntactic content of said electronic message;

b) comparing said syntactic content to a first database for a first match;

e) alerting said sender that said electronic message does not have an attachment, based on

said first match.

Chrabaszez discloses sending an email message which comprises ensuring the inclusion

of an attachment to be included with the email by comparing the syntactic content of an email

message with a database of keywords, and alerting a user that the email does not have an

attachment, based on the comparison and the determination that one of the keywords is present in

the email message – for the purpose of saving the sender from potential embarrassment of

forgetting to include an attachment (Summary, column 4 lines 35-58, column 5 lines 20-30 and

column 6 lines 1-15 & 40-50).

Chrabaszez fails to explicitly teach:

c) examining said addressed destination of said message to determine an identity of an

intended addressee; d) comparing said identity of said intended addressee to a second database

for a second match; and e) alerting said sender that said electronic message does not have an

attachment, based on said first match and said second match.

However, Meister teaches sending an email message which comprises verifying the

correctness of addressees in the email by comparing addressee to a database for a match, and

alerting the user based on the comparison (Abstract, Summary, column 2 lines 50-67, column 4

lines 18-55 and column 5 lines 1-37).

It would have been obvious for one of ordinary skill in the art to modify Chrabaszez by

also comparing the intended addressee with a second database as per the teachings of Meister so

that a user can be alerted that an email does not have an attachment, based on the first and second

comparisons and the determination that certain keywords and addressees are present in the email

message – for the purpose of saving the sender from potential embarrassment of forgetting to

include an attachment.

Chrabaszez fails to explicitly teach: f) automatically updating said first and said second

databases, provided that said attachment is attached to said message. However, Chrabaszez does

teach manually updating the databases (column 4 lines 35-60). Official notice is taken that

automating an activity to replace manual activity is well known in the art. It is not an invention

to broadly provide mechanical or automatic means to replace manual activity which

accomplishes the same result – *In re Venner, 120 USPQ 192, 194; 262 F2d 91 (CCPA 1958)*

§51.201.

It would have been obvious for one of ordinary skill in the art to modify Chrabaszez by

automatically updating said first and said second databases, provided that said attachment is

attached to said message because automating an activity to replace manual activity is well known

in the art.

8.   In reference to claim 2, Chrabaszez teaches the method as recited in Claim 1 wherein

said a) through b) versus said c) through d) may be performed, selectively, in any order, and

simultaneously (column 1 line 55 – column 2 line 35).

9.   In reference to claim 3, Chrabaszez teaches the method as recited in Claim 1 wherein

said first database comprises a list of specified terms indicating that an attachment is likely to be

desirable (column 6 lines 1-15).

10.   In reference to claim 4, Chrabaszez teaches the method as recited in Claim 3 wherein

said specified terms correspond to a high frequency of appearance within electronic messages

that have a high frequency of transmission with attachments (column 5 lines 20-40 and column

6 lines 1-15).

11.   In reference to claim 5, Chrabaszez teaches the method as recited in Claim 4 wherein

said b) further comprises recognizing elements of said syntactic content wherein said elements

comprise a plurality of syntactic terms (column 5 lines 20-40 and column 6 lines 1-15).

12.   In reference to claim 6, Chrabaszez teaches the method as recited in Claim 5 wherein

said step b) comprises:

c1) identifying certain terms of said plurality of syntactic terms that correspond to said

specified terms; c2) determining than any of said certain terms exist; and c3) triggering said e)

according to said c2) (column 5 lines 20-40 and column 6 lines 1-15).

13.   In reference to claims 8 and 9, Chrabaszez teaches the method as recited in Claim 1.

Chrabaszez fails to explicitly teach wherein said second database comprises a list of specified

addressees; and said specified addressees comprise a group of recipients of electronic mail

messages and wherein said electronic messages are characterized by a high frequency of

transmission with attachments.

However, Meister teaches sending an email message which comprises verifying the

correctness of addressees in the email by comparing addressee to a database for a match, and

alerting the user based on the comparison (Abstract, Summary, column 2 lines 50-67, column 4

lines 18-55 and column 5 lines 1-37).

It would have been obvious for one of ordinary skill in the art to modify Chrabaszez by

also comparing the intended addressee with a second database as per the teachings of Meister so

that a user can be alerted that an email does not have an attachment, based on the first and second

comparisons and the determination that certain keywords and addressees are present in the email

message – for the purpose of saving the sender from potential embarrassment of forgetting to

include an attachment.

14.   In reference to claim 10, Chrabaszez teaches the method as recited in Claim 9.

Chrabaszez fails to explicitly teach wherein said c) further comprises recognizing an address of

said addressee, wherein said address is an user identifier, a user name, a user email address, a

user Universal Resource Locator, or a user alias; and wherein said step d) further comprises: d1)

identifying said address as a certain addressee, wherein said certain addressee corresponds to one of said specified addressees; d2) determining that any of said certain addressees exist; and d3) triggering said e) according to said d2).

However, Meister teaches sending an email message which comprises verifying the correctness of addressees in the email by comparing addressee to a database for a match, and alerting the user based on the comparison (Abstract, Summary, column 2 lines 50-67, column 4 lines 18-55 and column 5 lines 1-37).

It would have been obvious for one of ordinary skill in the art to modify Chrabaszez by also comparing the intended addressee with a second database as per the teachings of Meister so that a user can be alerted that an email does not have an attachment, based on the first and second comparisons and the determination that certain keywords and addressees are present in the email message – for the purpose of saving the sender from potential embarrassment of forgetting to include an attachment.

15.   In reference to claim 13, Chrabaszez teaches the method as recited in Claim 1 wherein said step e) comprises activation of an on-screen display, a tone, synthesized speech, a pop-up window, a drop-down flag, or a combination (column 1 line 55 – column 2 line 35 and column 7 lines 1-20).

16.   In reference to claim 14, Chrabaszez teaches a method of sending an electronic message comprising:

a) examining content of said electronic message for selected keywords therein, said selected keywords being of a first database of keywords associated with messages that frequently have attachments sent therewith; b) provided said electronic message does not already have an

attachment associated therewith, alerting a user that said electronic message does not have an

attachment associated therewith provided one of said selected keyword is located within said

electronic message (Summary, column 4 lines 35-58, column 5 lines 20-30 and column 6 lines 1-

15 & 40-50); and

   c) provided said electronic message does have an attachment associated therewith,

updating said first database based on said content of said electronic message (column 5 lines 20-

30 and column 6 lines 1-15 & 40-50) .

17.   In reference to claim 15, Chrabaszez teaches the method as described in Claim 14

wherein said electronic message comprises an electronic mail message (column 4 lines 30-67).

18.   In reference to claim 16, Chrabaszez teaches the method as described in Claim 14

wherein said b) comprises displaying a message on a computer display screen that said electronic

message does not have an attachment associated therewith (column 7 lines 1-20).

19.   In reference to claim 17, Chrabaszez teaches the method as described in Claim 14 further

comprising:

   d) examining a recipient of said an electronic message against selected identifications,

said selected identifications being of a second database of identifications that are recipients of

messages that frequently have attachments sent therewith; e) provided said electronic message

does not already have an attachment associated therewith, alerting a user that said electronic

message does not have an attachment associated therewith provided one of said selected

identifications is said recipient of said electronic message (Summary, column 4 lines 35-58,

column 5 lines 20-30 and column 6 lines 1-15 & 40-50);

and f) provided said electronic message does have an attachment associated therewith, updating said second database based on said recipient of said electronic message (column 5 lines 20-30 and column 6 lines 1-15 & 40-50).

20.   In reference to claim 18, Chrabaszez teaches the method of sending an electronic message comprising:

a) examining a recipient of said electronic message against selected identifications, said selected identifications being of a first database of identifications that are recipients of messages that frequently have attachments sent therewith; b) provided said electronic message does not already have an attachment associated therewith, alerting a user that said electronic message does not have an attachment associated therewith provided one of said selected identifications is said recipient of said electronic message(Summary, column 4 lines 35-58, column 5 lines 20-30 and column 6 lines 1-15 & 40-50); and

c) provided said electronic message does have an attachment associated therewith, updating said first database based on said recipient of said electronic message (column 5 lines 20-30 and column 6 lines 1-15 & 40-50).

21.   In reference to claim 19, Chrabaszez teaches the method as described in Claim 18 wherein said electronic message comprises an electronic mail message (column 4 lines 30-67).

22.   In reference to claim 20, Chrabaszez teaches the method as described in Claim 18 wherein said b) comprises displaying a message on a computer display screen that said electronic message does not have an attachment associated therewith (column 7 lines 1-20).

Response to Amendment

23.   Examiner acknowledges the amendment filed on September 13, 2004. Applicant

cancelled claims 7 and 12.

Response to Arguments

24.   Applicant's arguments filed 9/13/2004 have been fully considered but they are not

persuasive. See above rejections.

25.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Ramy M Osman whose telephone number is (571) 272-4008.
The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
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RMO
February 4, 2005

SALEH NAJJAR
PRIMARY EXAMINER